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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RENEE M. KOVALES, EDITH S. STERN,
and BARRY E. WILLNER

Appeal 2010-011321
Application 09/782,772
Technology Center 2600

Before DEBRA K. STEPHENS, ERIC S. FRAHM, and
JOHNNY A. KUMAR, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3, 6-14, 17-33, 35, 37-41, 44-58, 61-68, and 71-88. Claims 2, 4, 5, 15, 16, 34, 36, 42, 43, 59, 60, 69, 70, and 89-91 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF CASE

Introduction

Appellants' invention relates to providing bookmarks for voice mail messages in order to facilitate improved navigation thereof (*see* Abstract).

Claim 1 reproduced below with disputed limitations emphasized, is illustrative of the claimed subject matter:

1. A method comprising:

providing bookmarks for a voice mail message by a caller leaving the voice mail message; and

creating a bookmarked message from the voice mail message and the bookmarks,

wherein at least two of the bookmarks are used to mark respective segments of the voice mail message as having degrees of importance, and wherein at least some of the bookmarks correspond to respective topics and some of the respective segments have different ones of the degrees of importance.

The Examiner's Rejections

The Examiner rejected claims 1, 3, 6, 7, 12-14, 17-20, 22-33, 35, 37, 41, 44-47, 49-58, 61, 62, 67, 68, 71, 72, and 74-88 under 35 U.S.C. § 103(a) as being unpatentable over Hamel (US 5,943,402, Aug. 24, 1999), in view of Valco (US 6,442,243 B1, Aug. 27, 2004). Ans. 3-8.

The Examiner rejected claims 8-10, 12, 38, 40, and 63-66 under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Valco further in view of Parsons (US 6,970,906 B1, Nov. 29, 2005). Ans. 8-9.

The Examiner rejected claims 11, 21, 39, 48, and 73 under 35 U.S.C. § 103(a) as being unpatentable over Hamel in view of Valco further in view of Haddock (US 5,742,736, Apr. 21, 1998). Ans. 9-10.

Appellants' Contentions

With respect to exemplary claim 1, Appellants contend that the Examiner erred in rejecting the claim because neither Hamel nor Valco teaches or suggests “at least two of the bookmarks are used to mark respective segments of the voice mail message as having degrees of importance” and “some of the respective segments have different ones of the degrees of importance.” (Br. 11). Appellants specifically point to the teachings of Valco (citing to col. 12, lines 55-59) related to the marking of voicemails as urgent or private (*id.*), and contend that “Valco only teaches marking an entire voicemail message with a single degree of importance, Valco *cannot* teach or suggest a single voice mail message having different degrees of importance associated therewith.” (Br. 11-12).

Finally, Appellants contend that neither Hamel nor Valco teaches or suggests bookmarks that not only segment a voicemail message, but also indicate the degree of importance associated with each segment. (*Id.*).

With respect to the remaining claims, Appellants recite the limitations of claims 7¹, 12, 13, 22, and 24², and assert that the references do not teach or suggest the limitations they are purported to teach (Br. 16-19).

Appellants further assert the patentability of claims 8-10, 12, 38, 40, and 63-

¹ Appellants admit that claims 37 and 62 “recite similar subject matter” as claim 7. (Br. 16).

² Appellants have grouped together claims 24, 49, and 74. (Br. 19).

66 based on the same reasons stated for claims 1, 33, and 57, respectively. (Br. 19). Finally, Appellants assert the patentability of claims 11, 21, 39, 48, and 73 based on the same reasons stated for claims 1, 33, and 57, respectively. (Br. 20).

Issue on Appeal

Has the Examiner erred in rejecting the claims as being obvious over Hamel and Valco because the references fail to teach or suggest “at least two of the bookmarks are used to mark respective segments of the voice mail message as having degrees of importance” and “some of the respective segments have different ones of the degrees of importance?”

ANALYSIS

Rejection #1: The Obviousness Rejection over Hamel and Valco

We have reviewed the Examiner’s rejections in light of Appellants’ contentions in the Appeal Brief (Br. 10-20) that the Examiner has erred. We disagree with Appellants’ conclusions.

We concur with the conclusions reached by the Examiner (Ans. 3-13). We also agree with the Examiner’s findings with respect to the individual references, and with the Examiner’s determination that it would have been obvious to combine the references based on the rationale set forth by the Examiner (Ans. 3-4). We note that each reference cited by the Examiner must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellants make arguments with regard to claim 1 (Br. 10-13) concerning the individual shortcomings in the teachings of each of the applied references to Hamel and Valco. We have carefully reviewed these arguments, however, and they are not convincing of the non-obviousness of the claimed invention set forth in representative claim 1. For example, Appellants criticize Hamel and Valco individually for not teaching or suggesting “at least two of the bookmarks are used to mark respective segments of voice mail messages as having degrees of importance” and that “some of the respective segments having different ones of the degrees of importance”, when the Examiner has relied upon the combination of Hamel and Valco to teach or suggest these features. One cannot show non-obviousness by attacking references individually when the rejection is based on a combination of references. *In re Merck*, 800 F.2d at 1097.

We note that the Examiner has combined Hamel’s “teach[ing] segmentation (bookmarking) of a voicemail message (Hamel Fig.3A-3B and col.1 lines 58-67)” with Valco’s “teach[ing] the degrees of importance (Valco col.12 lines 55-59).” (Ans. 11). We agree with the Examiner’s stated rationale for combining the references (*see, e.g.*, Ans. 3-4) and adopt them as our own.

Additionally, we note the Examiner has identified the relevant portions of Hamel and Valco and has properly equated the features disclosed in the references with the disputed features in claim 1. In response to each of the arguments raised by Appellants, the Examiner has presented detailed findings and responses (Ans. 3-13). We agree with these findings and conclusions and adopt them as our own. Regarding Appellants’ contention challenging the propriety of the rejection and whether the proposed

combination teaches or suggests all the claimed features, we find that the Examiner has articulated how the claimed features are met by the reference teachings with a rational underpinning to combine Hamel and Valco. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

With respect to the rejection of dependent claims 7, 12, 13, 22, and 24, we also agree with the Examiner's findings and conclusions (Ans. 4-13) that the combination of Hamel and Valco teaches or suggests the disputed features of these claims.

In view of the foregoing, we conclude that the inventions recited in claim 1 and claims 3, 6, 7, 12-14, 17-20, 22-33, 35, 37, 41, 44-47, 49-58, 61, 62, 67, 68, 71, 72, and 74-88, not separately argued, have not been shown to be patentably distinguishable from the combined teachings of the applied prior art.

Rejection #2: The Obviousness Rejection over Hamel, Valco, and Parsons

The Examiner finds that Hamel is "silent about disclosing wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; or an email address." Ans. 8. The Examiner cites Parsons as teaching these features. Ans. 8-9. The Examiner adds that it would have been obvious to combine the references, which are all in the same field—"managing voicemails." Ans. 8.

Appellants raise no new arguments for this rejection, instead relying on arguments that were previously addressed. Br. 19-20. For the same

reasons addressed above, we sustain the rejections of claims 8-10, 12, 38, 40, and 63-66.

Rejection #3: The Obviousness Rejection over Hamel, Valco, and Haddock

Appellants raise no new arguments for this rejection, instead relying on arguments that were previously addressed. Br. 20. For the same reasons addressed above, we sustain the rejections of claims 11, 21, 39, 48, and 73.

CONCLUSIONS

The Examiner's rejection of claims 1, 3, 6, 7, 12-14, 17-20, 22-33, 35, 37, 41, 44-47, 49-58, 61, 62, 67, 68, 71, 72, and 74-88 under 35 U.S.C. § 103(a) as being unpatentable over Hamel and Valco is affirmed.

The Examiner's rejection of claims 8-10, 12, 38, 40, and 63-66 under 35 U.S.C. § 103(a) as being unpatentable over Hamel, Valco and Parsons is affirmed.

The Examiner's rejection of claims 11, 21, 39, 48, and 73 under 35 U.S.C. § 103(a) as being unpatentable over Hamel, Valco, and Haddock is affirmed.

DECISION

The Examiner's rejections of claims 1, 3, 6-14, 17-33, 35, 37-41, 44-58, 61-68, and 71-88 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2010-011321
Application 09/782,772

AFFIRMED

msc